

REMARKS

Applicants have read and understood the subject Office Action and thank the Examiner for the reconsideration of the issues. Claims 1-20 are pending in this application. Of the pending claims, claims 1, 11, and 16 are independent. Upon return to prosecution from appeal, each of these independent claims again stands rejected under 35 U.S.C. §102 as potentially anticipated by Howe (U.S. 6,876,855) (hereinafter “Howe”).¹ Moreover, claims 11-20 stand rejected under §112 and claims 1-10 and 16-20 stand rejected under §101.

The §102 Rejections

In summary, this application was returned to prosecution by the pre-appeal panel, and the present Office Action followed. However, the prior Action’s misreading of Howe, which prompted the withdrawal of the prior Action, continues to be asserted in the present Action.

The claims and the Howe reference have been summarized in prior responses and Applicants’ request for brief review, and won’t be repeated herein except to note that such prior filings are incorporated herein by reference.

As to the substance, each independent claim contains a clear and simple express recitation that is absent in Howe. In particular, the pending independent claims recite assigning the local dialing number to the mobile device.

The Howe reference *does not* teach assigning the local dialing number to the mobile device. Applicants previously noted that Howe assigns a “temporary local director number” to a data unit rather than to the Howe mobile terminal. By way of response, the present Action asserts that “the mobile terminal is associated with the MIN of the data unit.” The Action’s apparent implication is that when the data unit is assigned a local number (TLDN), then the mobile unit is also somehow then assigned the same number by virtue of being “associated with” the data unit.

¹ Applicants again note that the action identifies Howe as U.S. 6,615,381, but that this number actually identifies a patent to Fukuda and not Howe. The form 892 attached to the first action correctly lists the number for Howe as 6,876,855. From the substance of the Action, it is assumed that the Action is discussing Howe and not Fukuda.

However, Howe's data unit simply **calls** the mobile unit; it does not become the mobile unit. The data unit has a local number, the mobile unit does not. The two are no more associated than my phone and your phone when I call you. My number does not become your number and your number does not become my number.

Consider this. The fact that a device has a number "assigned to it" means that you can call **that** device at **that** number. So imagine that you are the owner of the Howe mobile unit, and that we are following the Howe teachings. Can I really call you by dialing the TLDN simply because a data unit with that TLDN previously called you? Of course not. If I call the TLDN, I'll reach the data unit. So how does the data unit call you? It calls **your** number, not the TLDN. So is the TLDN number "assigned" to your phone? Well, clearly if I try to call you by dialing the TLDN, I will not reach you.

In the same way, you can try to call me by dialing my grandmother's number, but you will reach her, not me. And it doesn't matter that she calls me twice a week, you still can't call me by dialing her number.

The point is simply that a call between two numbers does not somehow jumble and reassign the numbers. The mobile device has a phone number, and that number remains the same **after** the call as it was **before** the call.

Because the claims contain express limitations that are clearly absent from Howe, the rejections of these claims under §102 in view of Howe are not legally proper, and favorable reconsideration is respectfully requested.

Moreover, since each of claims 2-10, 12-15 and 17-20 depends from one of the foregoing independent claims, it is respectfully submitted that these dependent claims are also patentable over Howe, asserted alone or in combination, for the reasons discussed above.

The §112 Rejections

Claims 16-20 stand rejected on the grounds that they recite a "computer-readable medium," and that one of skill in the art would not be enabled to practice this aspect of the

invention. However, those of skill in the art are, and were at the filing date, quite familiar with many computer-readable media. One must agree that a computer-readable medium is a medium that is readable by a computer. It surely goes without saying that on March 16, 2004, even those *lacking* skill in the art could easily identify floppy discs, DVDs, CDs, punch cards, and so on as computer-readable media.

The assumption that one of skill in the art would not understand how to use a floppy disc is not reasonable, and appears to be based on the lack of the verbatim words “computer-readable medium” in the specification. However, it is improper to assume that those of skill in the art are aware of nothing outside of the specification. Otherwise, they couldn’t even turn on their computers until the specification tells them where to find the switch!

Moreover, the application specifically teaches the use of software. *See, e.g.*, paragraph 28 of published application. As those of skill in the art are aware, there is simply no meaning for the term “software” other than that of computer-executable instructions on a computer-readable medium.² If the Office is using an alternative definition for the term “software” that is consistent with the specification and yet that does not denote computer-executable instructions on a computer-readable medium, Applicants respectfully request that such definition be provided.

Finally, the course of this prosecution shows that the Office itself had no trouble understanding the term “computer-readable media.” In fact, the present action again construes the term and goes on to allege that the prior art contains such a computer-readable medium. Surely it is now academic to assert that those of skill in the art would be confused by the term “computer-readable medium” when in fact, the Examiner had no trouble whatsoever understanding the term, and even pointed to alleged examples in the prior art.

Claims 11-15 are in means-plus-function format, and the Action asserts that it is not clear what the “means” for each element is. However, the Action does not identify any missing teaching other than to say again that the idea of software is implied in the claim and that software is not taught. However, as noted above, software is taught.

² *See* Webopedia: “Clearly, when you purchase a program, you are buying software. But to buy the software, you need to buy the disk (hardware) on which the software is recorded.”

Moreover, the Office has not yet presented a prima facie rejection of any of claims 11-15 under §112 since it has not met the requirements of MPEP §2181 (“The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function.”) The Office has not identified the recited functions or given any reason as why one of skill in the art would not understand the disclosed structure for performing that function.

The §101 Rejections

The Action rejects claims 1-10 and 16-20 under §101, alleging that the claimed invention requires a computer-readable medium.

With respect to claims 1-10, the Action asserts that since claim 16 recites a computer-readable medium, then claims 1-10 must also require this limitation. This logic is not understood, but it is clear that claims 1-10 are simple method claims and do not recite or imply a computer-readable medium. Perhaps its also worth noting that claims 1-10 are in no way dependent upon claim 16. Claim 16 is a separate independent claim (claim 1 is also independent, and claims 2-10 depend from claim 1, not claim 16).

With respect to claims 16-20, which *do* recite a computer-readable medium, the Action again alleges that those of skill in the art would not understand the meaning of the term “computer-readable medium.” As discussed above, it is very clear that the Office and those of skill in the art were not, and would not be, at all confused by the term.

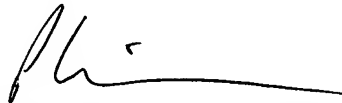
Conclusion

It is respectfully submitted that all claims require assigning a local dialing number to a mobile device. Howe teaches assigning a local number to a device other than the mobile device. The number of the mobile device itself is not changed during this process, and a local number is never assigned to the mobile unit itself.

With respect to the rejections under §112 and §101, the Action primarily asserts that the term "computer-readable medium" cannot be understood. This assertion is plainly incorrect, and is in fact belied by the Office's own conduct as well as the present specification.

Thus, it is respectfully submitted that the claims are patentable under §101, §102, §103, and §112, and favorable reconsideration is earnestly requested. If an interview would be helpful, please feel free to call the undersigned at your convenience.

Respectfully submitted,



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